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Docket No. 1349.1022/ MDS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE 10/19/00

In re Patent Application of:

Jae-ho MOON et al.

Serial No.: 09/426,644

Filed: October 25, 1999

Group Art Unit: 3729

Examiner: D. Tugbang

For: A PROCESS OF MANUFACTURING FLUID JETTING APPARATUSES, AND A  
FLUID JETTING DEVICE THEREOF

RESPONSE TO RESTRICTION REQUIREMENT AND AMENDMENT

Assistant Commissioner for  
Patents  
Washington, D.C. 20231

Sir:

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This is responsive to the Office Action mailed September 12, 2000, having a shortened period for response set to expire on October 12, 2000, the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect **Group I, claims 1 through 33** in response to the preliminary restriction requirement set forth in the Office Action.

Applicants provisionally elect Species A, claims 1, 2, 13, 17, 19, 21, 23, 24, 27, 30 and 31.

## II. Applicants Traverse the Requirement

The Examiner has already made an initial restriction requirement, mailed May 24, 2000, in which he indicated a restriction between Group I, claims 1-33, drawn to a method of manufacturing fluid jetting apparatuses, classified in class 29, subclass 611 and Group II, claims 34-36, drawn to a fluid jetting device, classified in class 239, subclass 102.1. As stated in the previous Response to Restriction Requirement, insofar as Group II is concerned, it is believed that claims 34 through 36 are so closely related to elected claims 1 through 33 that they should remain in the same application to preserve unity of the invention and to avoid any possibility of a double patenting issue arising at some later date.

x ( The elected claims 1 through 33 are directed to a process of manufacturing a plurality of fluid jetting apparatuses and claims 34 through 36 are directed to the fluid jetting apparatus. There have been no references cited to show any necessity for requiring restriction, and fact, it is believed that the Examiner would find references containing both method and product claims in the same field of technology. While it is noted that the Examiner has identified different classifications for the method and product claims, it is believed that classification is not conclusive on the question of restriction. It is believed, moreover, that evaluation of both sets of claims would not provide an undue burden upon the Examiner at this time in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by the Group II claims by filing a divisional application.

In item 5 of the restriction requirement, the Examiner has asserted that the application contains claims directed to the following distinct species of the claimed invention:

Species A, drawn to the embodiment of the heat driving part in FIGS. 4A-4B;

Species B, drawn to the embodiment of membrane in FIGS. 5A-5C;

Species C, drawn to the embodiment of the nozzle part in FIGS. 6A-6D;

Species D, drawn to the embodiment of adhering the membrane and the nozzle part in FIGS. 7A-7C; and

Species E, drawn to the embodiment of adhering the membrane and the heat driving part in FIGS. 8A-8B.

First of all, there is only one embodiment to the present invention relating to a process of manufacturing fluid jetting apparatuses as set forth in FIGS. 4A through 8B. Thus, the Applicants fail to see how there are five separate embodiments as asserted by the Examiner. As set forth at page 8, lines 18 through 19 of the present specification, "through the above-described process, the heat driving part 110, the membrane 120 and the nozzle part 130 are formed, respectively, and then adhered to each other." Thus, the disclosure in FIGS. 4A through 8B discloses one process on how to manufacture a plurality of fluid jetting apparatuses, and these figures do not show multiple embodiments as asserted by the Examiner.

Second, at page 3 of the restriction requirement, the Examiner asserts "currently, there appears to be no generic claims." This is totally not true. At least claims 1, 13, 17, 27 and 31 are generic claims that cover all of FIGS. 4A through 8B. Thus, if any of claims 1, 13, 17, 27 or 31 is finally held to be allowable, then the Examiner must search all of the claims depending therefrom.

In addition, there is no burden on the Examiner to conduct a search of all of Group I, claims 1-33. As stated at page 2 of the restriction requirement, the Examiner has set forth that all of claims 1-33 are classified in class 29, subclass 611. Thus, when the Examiner conducts

a search of any of the "asserted" embodiments of Species A through E, the Examiner will search the same material as he would for all of these species. Accordingly, there is no undue burden or hardship on the Examiner in searching all of these claims.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (P) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)-§806.04(i), §808.01(a) and §808.02). This section of the MPEP also states that for purposes of the initial requirement, a serious burden on the Examiner may be prima facie shown if the Examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP §808.02. The Examiner has not set forth any of these criteria or any other criteria for establishing that there would be a serious burden if restriction is required. As stated above, the Examiner has set forth that each of the "asserted" species are all drawn to the same class and subclass.

### III. Conclusion

Upon review of references involved in this field of technology, when considering that the product recited by the Group II claims as directed to a result of the method recited in the elected claims 1 through 33, the Species B through D all relate to a process of manufacturing a plurality of fluid jetting apparatuses which are part of the only disclosed embodiment of the specification in FIGS. 4A-8B, the elected claims 1, 2, 13, 17, 19, 21, 23, 24, 27, 30 and 31 read upon the same one embodiment, and when all of the various facts are taken into